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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,719	12/20/2005	Jordi Tormo I Blasco	4266-0131PUS1	8746
2292 7590 08/21/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER MURRAY, JEFFREY H				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
08/21/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/532,719

Applicant(s)

TORMO I BLASCO ET AL.

Examiner

JEFFREY H. MURRAY

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 10-14, 17 and 18 are pending in this application. Claims 1-9 have been cancelled. This action is in response to the applicants' response to an Ex Parte Quayle action filed on April 27, 2009. Therefore the Ex Parte Quayle action has been withdrawn and this current action replaces it. A new patent document has been located and it has been determined to be prior art. This document was not presented in the IDS statements.

Withdrawn Rejections/Objections

2. Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

Claim Objections

3. Claims 15 and 16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 15 depends from both claims 10 and claims 13 and does not express this dependency in the alternative format. In addition, claim 16 depends from this improper multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 15 and 16 have not been further treated on the merits.
4. Claim 16 is objected to because of the following informalities: The claim should read, "A process for the preparation **of** the compound...". Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

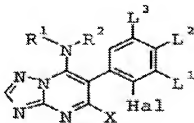
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over .

Pees, et. al.; U.S. Patent No. 5,593,996 in view of In re *Norris* (CCPA 1950) 179 F2d 970, 84 USPQ 458.

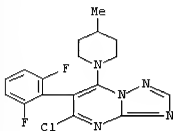
The current application teaches a compound of the following structure useful in combating fungi:



The prior art teaches the following compound in Table IIA in column 24 as compound #119 as a useful fungicide:

RN 187233-26-7 CAPLUS

CN [1,2,4]Triazolo[1,5-a]pyrimidine, 5-chloro-6-(2,6-difluorophenyl)-7-(4-methyl-1-piperidiny)- (CA INDEX NAME)



The compound in the prior art reads on the compound of the current application but for one issue. The current application permits the phenyl ring to contain a 2-chloro group and a fluoro group in the 3-, 4-, or 5-position, but not the 6-position.

It is well known in the art that compounds having the same radical at different positions on the nucleus are position isomers. Their properties are often so nearly alike as to present difficulties in identification or separation. Ex *parte Mowry* (POBA 1950) 91 USPQ 219. A novel, useful compound which is isomeric with a compound of the prior art is unpatentable unless it possesses some unobvious or unexpected beneficial property not possessed by the prior art compound. In *re Norris* (CCPA 1950) 179 F2d 970, 84 USPQ 458; In *re Finley* (CCPA 1949) 174 F2d 130 and 135, 81 USPQ 383 and 387.

A compound need not be an adjacent homolog or position isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness; the name used to designate the structural relationship between compounds is not controlling, it is the closeness of that relationship. In *re Payne et al.* (CCPA 1979) 606

F2d 303, 203 USPQ 245. When chemical compounds have "very close" structural similarities...without more, a *prima face* case of obviousness may be made. *In re Grabiak* (CAFC 1985) 769 F2d 729, 226 USPQ 870.

Pees, et. al. combined with *In re Norris* shows the necessary teachings that suggest shifting the fluoro group from the 6-position to the 4-position of the phenyl ring in an attempt to enhance activity and afford a positive benefit from the replacement. It would have been obvious to one skilled in the arts at the time of the invention to be motivated to combine Pees, et. al. and the law of *In re Norris* to synthesize the prior art compound above where the fluoro group of the phenyl ring was located in the 4-position instead of the 6-position. No new matter permitted. Appropriate correction is required.

Conclusion

6. Claims 10-18 are rejected.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/
Patent Examiner, Art Unit 1624

/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624